

Curry et al.
Serial no. 09/683,706
Filed 2/5/2002
Attorney docket no. 1049.001US1

Page 6

REMARKS

Claim rejections under 35 USC 103 as to Budge in view of Shaffer

Claims 1-2, 8-14, and 19-20 have been rejected under 35 USC 103(a) as being unpatentable over Budge (6,564,248) in view of Shaffer (6,145,083). Claims 1, 12, and 19 are independent claims, from which claims 2, 8-11, 13-14, and 20 depend. Applicant submits that claims 1, 12, and 19 are patentable over Budge in view of Shaffer, such claims 2, 8-11, 13-14, and 20 are patentable for at least the same reasons.

Applicant specifically discusses claim 12 as representative of claims 1, 12, and 19 insofar as patentability over Budge in view of Shaffer is concerned. Claim 12 is limited to "an audio or video program encompassing the one or more audio or video controls [being] *integrated with* the predetermined application program," where "the audio or video program [is] *separate from* the predetermined application program." That is, claim 12 has two specific limitations that are discussed herein: (1) the audio or video program encompassing the audio or video controls is "integrated with" the predetermined application program, but (2) the audio or video program is also "separate from" the predetermined application program.

Applicant contends that these limitations are not found in Budge in view of Shaffer, or that Budge in view of Shaffer does not render these limitations obvious, for the following reasons. First, Budge in view of Shaffer does not disclose a program, like the audio or video program, being integrated with but separate from another program, like the predetermined application program. Second, Budge is not properly combined with Schaffer. Each of these reasons is now discussed in detail.

Curry et al.
Serial no. 09/683,706
Filed 2/5/2002
Attorney docket no. 1049.001US1

Page 7

Budge in view of Shaffer does not disclose two programs integrated but separate

First, Budge in view of Shaffer does not disclose an audio or video program being integrated with but separate from a predetermined application program. The Examiner indicates that

Budge does teach the predetermined application program and the audio or video program. Budge, however, does not explicitly teach the programs separate but integrate[d]. Shaffer teaches the program[s] separate but integrate[d].

(Final Office Action, p. 3, paras. b-c) Because the Examiner relies specifically upon Shaffer in teaching separate but integrated programs, Applicant discusses Shaffer in particular to show why Budge in view of Shaffer does not disclose an audio or video program being integrated with but separate from a predetermined application program, as in the claimed invention.

The Examiner specifically relies upon column 4, line 62, through column 5, line 12 of Shaffer as disclosing a program that is separate from but integrated with another program. The relevant portion of this excerpt of Shaffer specifically reads as follows.

While FIG. 2 shows the TOL and the screen saver as separate applications, in the preferred embodiment the two capabilities are integrated into a single application. If the two capabilities are implemented in separate applications, an arbitrating application may be used to manage the two applications, thereby providing compatibility.

Shaffer thus teaches two different embodiments. First, two different functionalities or capabilities, TOL and screen saver capabilities, may be implemented in separate application programs. Second, these two functionalities or capabilities may be implemented in a single application program. Applicant discusses each of these embodiments taught by Shaffer to show why Budge in view of Shaffer does not disclose a program that is "separate from but integrated with" another program, as in the claimed invention.

First, Shaffer discloses two different capabilities being implemented in separate application programs. This is similar to the claimed invention in that the invention also uses two separate

Curry et al.
Serial no. 09/683,706
Filed 2/5/2002
Attorney docket no. 1049.001US1

Page 8

programs. However, in this embodiment of Shaffer, there is no disclosure of having the two programs "integrated" with one another, as in the claimed invention. The Examiner states that the Shaffer excerpt quoted above says "separate application[s] . . . are integrated into a single application." However, by using an ellipsis (" . . . ") the Examiner greatly and improperly changes what Shaffer is actually disclosing. Shaffer actually says that "While FIG. 2 shows the TOL and the screen saver as separate applications, in the preferred embodiment the two capabilities are integrated into a single application." Thus, the Examiner has taken one part of the while clause, and combined it with a completely different type of disclosure in the remaining part of the sentence, changing the intended meaning of and what is actually disclosed in and taught by Shaffer. Shaffer does not disclose that the separate applications are integrated into a single application, but rather, to paraphrase, that "while in one embodiment the two capabilities are in separate applications, in the preferred embodiment the two capabilities are integrated into a single application." Shaffer, in other words, discloses that the capabilities may be in *two separate programs* ~~OR~~ that these capabilities may be *integrated within one program*, not that the two separate programs *themselves* are integrated with one another.

In sum, whereas Shaffer discloses two separate programs, it does not disclose the two separate programs being integrated with one another. Indeed, Shaffer states that "If the two capabilities are implemented in *separate applications*, an arbitrating application may used to manage the two applications, thereby providing compatibility." That is, where two separate programs are used, as in the claimed invention, the two separate programs are not integrated, because a third, arbitrating program is required to manage the two separate programs to provide compatibility between the two separate programs. Inherently, if the two separate programs were truly integrated, as in the claimed invention, then no such additional arbitrating program would ever be needed to provide compatibility between the two separate programs. In the claimed invention, the two separate programs are integrated, whereas Shaffer teaches that a third

Curry et al.
Serial no. 09/683,706
Filed 2/5/2002
Attorney docket no. 1049.001US1

Page 9

arbitrating program can be used because the two separate programs are not integrated. For this reason, Budge in view of Shaffer does not teach the claimed invention.

Second, Shaffer also discloses the two different capabilities being implemented "in a single application program." On its face, this aspect of Shaffer does not allow Budge in view of Shaffer to teach the claimed invention, since the claimed invention is limited to two programs being "separate," albeit integrated with one another. For this reason, too, Budge in view of Shaffer does not teach the claimed invention.

Budge is not properly combined with Shaffer

The Examiner's stated reason for combining Budge with Shaffer is as follows.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Shaffer and Budge because Shaffer's teaching would have provided the capability for accommodating the combination of the two programs within a single computing device, and therefore, provid[ing] compatibility for Budge's system.

(Final Office Action, pp. 3-4, para. d) This stated reason for combining Budge with Shaffer, however, does not make sense on a number of different levels, such that in actuality there is no reason within the prior art to combine Budge with Shaffer.

First, the Examiner states that "Shaffer's teaching would have provided the capability for accommodating the combination of the two programs within a single computing device." However, Budge *already discloses* using the combination of two programs within a single computing device, such as the single computing device 2 or 4 of FIG. 1 thereof. That is, Budge already teaches using the combination of a predetermined application program and an audio or video program within a single computing device. There is no reason to combine Shaffer with Budge to achieve this functionality, because Budge already provides this functionality itself. For this reason alone, there is no motivation within the prior art to combine Shaffer with Budge, such that combining Budge with Shaffer is improper.

Curry et al.
Serial no. 09/683,706
Filed 2/5/2002
Attorney docket no. 1049.001US1

Page 10

Second, the Examiner states that compatibility for Budge's system would be provided by combining Budge with Shaffer. This statement is incorrect, because Budge is completely compatible in and of itself. The predetermined application program and the audio or video program of Budge are taught and disclosed within Budge as running on the computing device, or system, 2 or 4 of FIG. 1. No extra "compatibility" is needed or gained by combining Budge with Schaffer. Because Budge is completely compatible by itself, in that the predetermined application program and the audio or video program of Budge already can run in combination on the system of Budge without any problems, there is no reason to combine Shaffer with Budge to achieve this functionality. For this reason, too, there is no motivation within the prior art to combine Shaffer with Budge, such that combining Budge with Shaffer is improper.

In sum, Applicant notes the MPEP instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination." (MPEP sec. 2143.01) In the present situation, Shaffer may very well *be able to be* combined with Budge. However, there is no *reason* within the prior art why such a combination is *desirable*. First, Shaffer does not provide Budge with the capability for accommodating the combination of the two programs within a single computing device, since Budge already has this capability. Indeed, the Examiner does not state why providing Budge with the capability for accommodating the combination of the two programs within a single computing device is even desirable, as required by the MPEP. Just because Shaffer *could* provide Budge with such capability does not mean that Budge *should* be "provided" with such capability, especially where Budge already *has* this capability. Second, and similarly, Shaffer does not provide Budge with "compatibility" for Budge's system, since Budge already has such compatibility. There is no reason why it is desirable to combine Shaffer with Budge, such that combining Budge with Shaffer is improper.

Curry et al.
Serial no. 09/683,706
Filed 2/5/2002
Attorney docket no. 1049.001US1

Page 11

Claim rejections under 35 USC 103 as to Budge in view of Shaffer and further in view of Poreh

Claims 3-7 and 15-18 have been rejected under 35 USC 103(a) as being unpatentable over Budge in view of Shaffer, and further in view of Poreh (5,889,518). However, claims 3-7 and 15-18 are dependent claims, depending from the independent claims discussed above in relation to the claim rejections as to Budge in view of Shaffer. Therefore, claims 3-17 and 15-18 are patentable for at least the same reasons that their base independent claims are patentable.

Conclusion

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited. Applicant strongly contends that the Examiner's rejection of the claimed invention would not be sustained on appeal.

Respectfully Submitted,



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Date

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